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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/976,656 | 10/12/2001 | Lester Sussman | | 1373 |
| 7590 | 02/18/2005 | | EXAMINER | |
| LESTER SUSSMAN | | | VO, HUYEN X | |
| 9213 BULLS RUN PARKWAY | | | | |
| BETHESDA, MD 20817-2403 | | | ART UNIT | PAPER NUMBER |
| | | | 2655 | |

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/976,656 | SUSSMAN, LESTER | |
| | Examiner | Art Unit | |
| | Huyen Vo | 2655 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 October 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 18-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 October 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. Applicant's arguments with respect to claims 18-31 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Paleiov et al. (US 6560320).

4. Regarding claim 30, Paleiov et al. disclose a computerized interactive voice response system comprising: an interactive voice response host computer for providing audio menus (*IVR 28 in figure 1*); a user telephone (*element 30 or 34 and 36 combined in figure 1*); a source computer for providing text menus associated with said audio menus (*authoring tool 29 in figure 1*); a user telephone with an embedded computer having a display screen and having a program to display visual menus on the user embedded computer display screen and wherein said user embedded computer is

capable of operating independently and not in connection with said user telephone (*element 30 or 34 and 36 combined in figure 1*); a computer network communication means attached to said user embedded computer for receiving data to display visual menus and other data on the said user embedded computer display screen from a source computer (*PSTN network 26 in figure 1*); an interface for connecting the user telephone, and the interactive voice response host computer, wherein said interface connects the user telephone to the interactive voice response host computer, enabling sending signals from the user telephone to the interactive voice response host computer (*figure 1, telephone is connected to IVR*); wherein the said embedded computer has the means to convert voice signals to computer readable and storable data, said storable data include visual menus and other data (*element 30 or 34 and 36 combined in figure 1, analog voice signal is first converted into digital representation so that it can be processed by the computer before transmitted to other communications devices*); wherein said embedded computer has memory means to store said visual menus and other data (*buffer memory is inherently included in telephone device 30 and/or 34 and 36 combined*); and wherein the program in the user telephone embedded computer enables the user computer display screen to display said converted voice signal as visual menus along with the audio menus provided to the user telephone (*col. 8, lines 54-67*).

5. Regarding claim 31, Paleiov et al. further disclose the system of claim 30 wherein said interface further includes means for converting signals from said user telephone embedded computer into tones to be received by said interactive voice response host

computer, thereby enabling selection of menu items from an input device connected to said user telephone embedded computer (*figure 3, particularly elements 60-62*).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paleiov et al. (US 6560320) in view of Rosen et al. (US 6014090).

8. Regarding claims 18 and 24, Paleiov et al. disclose a computerized interactive voice response system comprising: an interactive voice response host computer for providing audio menus (*IVR 28 in figure 1*); a source computer for providing text data associated with said audio menus (*authoring tool 29 in figure 1*); a user telephone (*element 30 or 34*); a user telephone with an embedded computer having a display screen and having a first program to display visual menus on the user embedded computer display screen and wherein said user embedded computer is capable of operating independently and not in connection with said user telephone (*element 30 or 34 and 36 combined in figure 1*); an interface for connecting the user telephone, and said interactive voice response host computer, wherein said interface connects said

user telephone to said interactive voice response host computer on a first communications network, enabling sending signals from said user telephone to said interactive voice response host computer (*PSTN 26 in figure 1*); a modem attached to said user embedded computer for receiving said text data to display visual menus and other data on said user embedded computer display screen from a source computer (*figure 1, telephone is connected to server*); wherein said first communications network is a public switched telephone network (*PSTN 26 in figure 1*); wherein said embedded computer has memory means to store said visual menus and other data (*buffer memory is inherently included in the telephone device 30 and/or 34 and 36 combined*); wherein said visual menus comprise said text data, said text data pre-stored in said memory, retrieved from said source computer prior to connecting to said interactive voice response host computer (*authoring tool 29 sends text information to IVR 28 and ultimately to telephone devices*); wherein said first program in said user telephone embedded computer enables said user computer display screen to display said visual menus whenever a dialed telephone number has associated audio menus provided by said interactive voice response host computer (*display on element 36 and 32 in figure 1 and/or referring to col. 5, lines 11-44*); wherein said first program in said user telephone embedded computer provides navigation means to explore and select menu options in said visual menus prior to connecting to said interactive voice response host computer, transmitting said signals of said selection from said user telephone to said interactive voice response host computer after selecting said menu options (*col. 9, lines 44-59, the user is able to navigate from field to fields*); wherein said pre-stored visual menus reside

on said source computer, accessible by said user telephone by means of said modem on a computer communications network (*authoring tool 29 sends information to IVR 28 and ultimately to telephone devices for display*); and said pre-stored text data comprise menu text data (*authoring tool 29 in figure 1*).

Paleiov et al. fail to specifically disclose that the pre-stored text data comprises location data of said source computer on said computer communications network. However, Rosen et al. teach that the pre-stored text data comprises location data of said source computer on said computer communications network (*col. 6, lines 5-25*).

Since Paleiov et al. and Rosen et al. are analogous art because they are from the same field of endeavors, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Paleiov et al. by incorporating the teaching of Rosen et al. in order to establish communication between the client device and appropriate source computer or server to enable the client device to retrieve further data from that particular source computer or server.

9. Regarding claims 18 and 25, Paleiov et al. further disclose means for ensuring that said displayed visual menus correspond to said audio menus provided, and providing means to retrieve, during said connection to said interactive voice response host computer, a correct version of visual menus from said source computer if said visual menus and said audio menus do not correspond (*col. 9, lines 18-30, if error is detected, requesting the IVR to resend menus data*).

10. Regarding claims 20 and 26, Paleiov et al. further disclose that the interface further includes means for converting signals from said user telephone embedded computer into tones to be received by said interactive voice response host computer, thereby enabling selection of menu items from an input device connected to said user telephone embedded computer (*figure 3, particularly elements 60-62*).

11. Regarding claims 21 and 29, Paleiov et al. further disclose that the modem is an analog modem (*telephone device include analog modem*). Paleiov et al. fail to specifically disclose that the computer communications network is the internet, a broadband network means, or an Ethernet network means, or a wireless 802.11b means, or a wireless Bluetooth means. However, the examiner takes official notice that it would have been obvious internet, a broadband network means, or an Ethernet network means, or a wireless 802.11b means, or a wireless Bluetooth means are well known in the art. The advantage each of these communication networks is to support communications between client devices and server.

12. Regarding claims 22 and 27, Paleiov et al. further disclose that the embedded computer has a control program capable of receiving notification of an update to said visual menus from said source computer by said computer communications network (*the operation of figure 3 or referring to col. 7, line 56 to col. 9, line 67, a communication protocol would include notification/signaling feature in order to make sure when and how much data should be transferred/received by either communication devices*);

retrieving said update from said source computer, on said computer communications network; and storing said visual menus update in said computer memory (*the operation of figure 3 or referring to col. 7, line 56 to col. 9, line 67*).

13. Regarding claims 23 and 28, Paleiov et al. further disclose that the system has means to download from a second host computer, and to store other data associated with the telephone call prior to telephone call being made (*the operation of figure 3 or referring to col. 7, line 56 to col. 9, line 67*). Paleiov et al. fail to disclose that the other data includes restaurant menus, medical schedules and prescriptions, mail order catalogs, product licensing information, tickets for events and travel and billing information. However, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Paleiov et al. to include restaurant menus, medical schedules and prescriptions, mail order catalogs, product licensing information, tickets for events and travel and billing information in order to provide advertisements to users.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Vo whose telephone number is 703-305-8665. The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on 703-305-4827. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Huyen X. Vo

February 16, 2005


SUSAN MCFADDEN
PRIMARY EXAMINER